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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,631	05/25/2000	William H. Barber	387953	5757

7590 12/19/2002

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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT PAPER NUMBER

3627

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/578,631

Applicant(s)

BARBER, WILLIAM H.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-56 and 59-83 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 57, 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Inventorship

1. In view of the papers filed Nov. 6, 2002, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Philip J. Tomasi.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Response to Amendment

2. The Declaration filed on Nov. 6, 2002 and Supplemental Transmittal filed Nov. 7, 2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hamm et al. reference.

The Declaration does not include an allegation that the acts relied upon were carried out in this country or in a NAFTA country or WTO member country. See 35 USC 104.

Also, the Declaration is not made by all the inventors of the claimed subject matter, nor is there an explanation why Philip J. Tomasi has not made a declaration. See MPEP 715.04.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 18, 20, 21, 23, 24, 26, 43, 50, 51, 53, 59, 61, 62, 64, 65, 67 and 68 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hamm et al. Hamm et al disclose a vending system that dispenses CDs, see col. 3, lines 8-15, from kiosks 24 which have processors 72 which communicate with server processor 12. Credit card payment and credit check with ACH 22 are disclosed in col. 3, lines 53-65. Transmitting billing information to the customer for the purchases is disclosed in col. 6, lines 22-25 and providing the customer with a receipt is disclosed in col. 7, lines 8-13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8, 27-29, 42, 44-53, 60-62, 69, 70 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Hamm et al. Kanoh et al show kiosks 3, which dispense CDs, see col.

1, lines 7-12, and receive them back. The kiosks of Kanoh et al are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13-16. Kanoh et al maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al do not disclose transmitting a receipt to the user. Hamm et al disclose in col. 7, lines 8-13 transmitting a receipt to the user to verify purchases and maintain expense records for business and tax purposes. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Hamm et al to provide the device of Kanoh et al with means to transmit to the user a receipt to verify purchases and maintain expense records for business and tax purposes.

Claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Hamm et al as applied to claim 2 above, and further in view of Brindze et al. Kanoh et al, as modified by Hamm et al, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. Brindze et al

show CDs with unique concentric markings to keep track of each CD. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Brindze et al to provide the CDs of Kanoh et al with unique concentric markings to keep track of each CD.

Claims 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Reid et al. Hamm et al show all the features of the applicant's claimed invention except a storage carousel for the CDs. Reid et al show a storage carousel 32 for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Reid et al for the storage means of Hamm et al since they are equivalent and either would work equally well in the dispenser of Hamm et al.

Claims 13, 54, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Takahashi et al. Hamm et al disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in

Takahashi et al to provide the device of Hamm et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Hamm et al as applied to claim 2 above, and further in view of Takahashi et al. Kanoh et al, as modified by Hamm et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 22, 36-38, 63 and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Kitchen et al. Hamm et al show all the features of the applicant's claimed invention except transmitting the bill by e-mail. Kitchen et al disclose a bill paying system in which bills are transmitted to the payor by e-mail, see col. 7, lines 6-16. It would have been obvious to one of ordinary skill in the art

in view of the showing and teaching of Kitchen et al to send the bills to the customers in Hamm et al by e-mail.

Claims 25, 34, 35, 66, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Dedrick. Hamm et al show all the features of the applicant's claimed invention except sending advertisements according to a user profile. Dedrick discloses sending advertisements according to a user profile. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Dedrick to tailor the advertisement in Hamm et al according to user profiles.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Iida. Hamm et al show all the features of the applicant's claimed invention except an optical writing system. Iida disclose an optical writer 28 that writes data to the CDs. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Hamm et al with an optical writer to write data to the CDs.

Claims 39-41 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamm et al in view of Iida. Hamm et al show all the features of the applicant's claimed invention except a casing with an address and packaging for mailing. Iida discloses a casing and address label and packaging for mailing the CDs in col. 15, lines 16-22. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Hamm et al with a casing and means to address and mail the CDs.

Claims 1-8, 18, 20, 21, 23, 24, 26-29, 42-53, 59-62, 64, 65, 67-70 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al (4,812,629 of record). Kanoh et al show kiosks 3, which dispense CDs, see col. 1, lines 7-12, and receive them back. The kiosks of Kanoh et al are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13-16. Kanoh et al maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al do not disclose transmitting a receipt to the user.

O'Neil et al disclose in col. 8, lines 26-40 transmitting a receipt to printer 112 to provide a record of the transaction to the customer. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of O'Neil et al to provide the device of Kanoh et al with means to transmit to the user a receipt to provide the customer with a record of the transaction.

Claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 2 above, and further in view of Brindze et al. Kanoh et al, as modified by O'Neil et al, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. Brindze et al show CDs with unique concentric markings to keep track of each CD. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Brindze et al to provide the CDs of Kanoh et al with unique concentric markings to keep track of each CD.

Claims 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further in view of Reid et al. Kanoh et al, as modified by O'Neil

et al, show all the features of the applicant's claimed invention except a storage carousel for the CDs. Reid et al show a storage carousel 32 for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Reid et al for the storage means of Kanoh et al since they are equivalent and either would work equally well in the dispenser of Kanoh et al.

Claims 13, 54, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further in view of Takahashi et al. Kanoh et al, as modified by O'Neil et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 2 above, and further in view of Takahashi et al. Kanoh et al, as

modified by O'Neil et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 22, 36-38, 63 and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further in view of Kitchen et al. Kanoh et al, as modified by O'Neil, show all the features of the applicant's claimed invention except transmitting the bill by e-mail. Kitchen et al disclose a bill paying system in which bills are transmitted to the payor by e-mail, see col. 7, lines 6-16. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Kitchen et al to send the bills to the customers in Kanoh et al by e-mail.

Claims 25, 34, 35, 66, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further et al in view of Dedrick. Kanoh et al,

as modified by O'Neil et al, show all the features of the applicant's claimed invention except sending advertisements according to a user profile. Dedrick discloses sending advertisements according to a user profile. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Dedrick to tailor the advertisement in Kanoh et al according to user profiles.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by O'Neil et al, show all the features of the applicant's claimed invention except an optical writing system. Iida disclose an optical writer 28 that writes data to the CDs. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with an optical writer to write data to the CDs.

Claims 39-41 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of O'Neil et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by O'Neil et al, show all the features of the applicant's claimed invention except a

casing with an address and packaging for mailing. Iida discloses a casing and address label and packaging for mailing the CDs in col. 15, lines 16-22. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with a casing and means to address and mail the CDs.

Allowable Subject Matter

Claims 16, 17, 57 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

The applicants' remarks have been considered but have not been found persuasive in view of the new grounds of rejection and since the Declaration under 37CFR1.131 was found insufficient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J.

BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

fjb
December 13, 2002


F. J. BARTUSKA
PRIMARY EXAMINER 12/16/02